

**REMARKS/ARGUMENTS**

Favorable reconsideration of this application is respectfully requested.

Claims 1-129, 133-135, 139, 140, 143, and 150-174 are pending in this application.

Claims 130-132, 136-138, 141, 142, and 144-149 were previously canceled without prejudice or disclaimer. The outstanding Office Action further withdraws Claims 120-129, 133-135, 139, 140, 143, and 150-174 from consideration

It is noted that this application was subject to an Election of Species Requirement mailed on October 8, 2003, and a response was filed on January 8, 2004, that elected the species noted in the Requirement to be “A/Species of Figs. 1 and 3,” without traverse. This January 8, 2004, response further indicated that Claims 1-119, 121-129, and 151-174 read on the elected species.

The outstanding Quayle Action acknowledges this election without traverse but now withdraws the Election of Species Requirement that has been in place for over two years and substitutes a finding that the original Patent Claims 1-119 have been “constructively elected” in this reissue application. The basis for this “constructively elected” finding offered in the outstanding Quayle Action is the observation that new Claim 120 has features not found in original Claim 1. Based only on this example offered as to Claim 120, the outstanding Quayle Action states that all of the pending newly added Claims 120-129, 133-135, 139, 140, 143 and 150-174 would have been restricted from the original patent claims had they been presented earlier and withdraws all of these claims from consideration. As authority for this withdrawal, the outstanding Quayle Action cites 37 CFR § 1.176 and MPEP §§1450 and 1451.

However, while 37 CFR § 1.176 permits the U.S. Patent and Trademark Office (PTO) to make a restriction between the subject matter of the original patent claims and previously unclaimed subject matter, nothing in this section states that the restriction guidelines in the

MPEP are not controlling. In this last regard, the guidelines of MPEP § 1450<sup>1</sup> require that any Restriction or Election of Species Requirement in a reissue application must be part of an Office Action that meets four requirements, as follows:

Where a restriction requirement is made by the examiner, the original patent claims will be held to be constructively elected (except for the limited situation where a disclaimer is filed as discussed in the next paragraph). Thus, the examiner will issue an Office action in the reissue application (1) providing notification of the restriction requirement, (2) holding the added claims to be constructively non-elected and withdrawn from consideration, (3) treating the original patent claims on the merits, and (4) informing applicant that if the original claims are found allowable, and a divisional application has been filed for the non-elected claims, further action in the application will be suspended, pending resolution of the divisional application.

This section also states that “[t]he criteria for making a restriction requirement in a reissue application between the newly added claims and the original claims are the same as that applied in a non-reissue application.” See MPEP §§ 806.05(a) through 806.05(i) as to such requirements.

The outstanding Quayle Action clearly fails to provide the required item (1) notification of any assertion of distinctness in terms of any assertion of distinctness as to MPEP §§ 806.05(a) through 806.05(i). Also, if a Restriction based upon distinctness is being asserted, the grouping of claims into their respective categories relative to the MPEP §§806.05(a)-(i) criteria and the reasons for insisting on restriction are needed as indicated in MPEP §806.05(j) and have not been presented. These missing claim groupings and/or a new identification of specific species are important because MPEP § 1450 notes that the reissue applicant is to be “permitted to file a divisional reissue application for each of the several separate and distinct inventions identified in the examiner’s restriction requirement.”

Instead of the such notification, the outstanding Quayle Action merely sets forth an unsubstantiated conclusion that all of Claims 120-129, 133-135, 139, 140, 143, and 150-174 could have been restricted if originally presented with Claim 1-119 and the observation that

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<sup>1</sup> All references to the MPEP in this response are to the latest revision, i.e., Revision 3, August 2005.

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features present in Claim 120 do not appear in original Claim 1. As the species of the subject matter of Claim 120 and the species of Claims 1-119, 121-129, and 151-174 are different, the observation that features present in Claim 120 do not appear in original Claim 1 merely establishes that these claims are not drawn to the same species. It does not establish that the invention of Claim 1 can be considered to be distinct from that of any of Claims 121-129 or 151-174, for example.

While MPEP § 1450 also permits an election of species requirement, such a requirement was already made on October 8, 2003, and a response was filed on January 8, 2004, that elected the species noted in that Requirement to be “A/Species of Figs. 1 and 3,” as set forth above. As further noted above, this January 8, 2004, response further indicated that Claims 1-119, 121-129, and 151-174 all read on this elected species (“A/Species of Figs. 1 and 3”).

While the above-noted item (2) requirement of holding the added claims to be constructively non-elected and withdrawn from consideration and the item (3) requirement of treating the original patent claims on the merits have been met, the item (4) requirement has further not been addressed in the outstanding Quayle Action. In this last regard, the MPEP § 1450 required notice that there will be a suspension of further action in this reissue application pending resolution as to any divisional reissue application that is filed based upon this Restriction/Election Requirement has not been set forth.

Accordingly, it is believed that the outstanding Quayle Action fails to comply with the guidelines of MPEP § 1450 and that this outstanding Quayle Action should now be withdrawn.

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In light of the foregoing, it is believed that no other issues remain outstanding in this application, such that it is believed that this application is clearly in condition for formal allowance and, accordingly, an early and favorable action to this effect is respectfully requested.

Respectfully submitted,

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